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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/715,724	09/16/96	WILSON	8000

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D3M1/0919

EXAMINER
MORRIS, T

ART UNIT	PAPER NUMBER
1314	72

DATE MAILED: 09/19/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

08/715,724

Applicant(s)

Wilson et al.

Examiner

Terrel Morris

Group Art Unit

1314



☒ Responsive to communication(s) filed on Jul 24, 1997

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5, 9-11, 13-15, and 18-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 9-11, 13-15, and 18-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant's amendments and accompanying remarks filed July 24, 1997 have been carefully considered. The amendments introduce some confusion that was not present in the originally filed claims. In addition, the prior art is still found to render the claimed invention unpatentable, substantially as set forth in the last Office action.
2. Claims 1-5, 9-11, 13-15, and 18-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, the formula of part (b) of claim 1 lacks description and therefore support in the specification.

3. Claims 1-5, 9-11, 13-15, and 18-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 1, line 7, it is confusing to refer to a second polyamide when there is no first polyamide. In claim 1, part (b), the formula has changed and is now unclear.

In claim 20, is part (b) intended to refer to a ketone linkage? There is no bond indicated between the -C- and the O.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 1-5, 9-11, and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin, US 5,447,794 as was set forth in section 3 of the last Office action.

To the independent claims, Applicant has added language that the core is nylon 6 and the sheath is from about 3 to 15 wt% of the fiber. Lin teaches that the core of the disclosed polymer is either nylon 6,6 or nylon 6. As such, the reference anticipates the now claimed core. The patent also teaches that the ratio of sheath to core is 10:90 to 80:20, preferably 10:90 to 50:50. This significantly overlaps the claimed range and thus anticipates the newly added feature. New claim 20 appears to have substantially the same scope as claim 1 just with the sheath content range being slightly more narrow. Still, Lin anticipates at least one point in the range claimed, thus anticipating the claim as a whole.

Applicant traverses this rejection stating that at best Lin and the present invention are related as genus and specie and that it is well settled that there is no anticipation where one has to pick and choose from among different materials described in a genus to arrive at a species. This may be true except for a couple of points. It depends on the number of elements in the genus. For instance, it may not be obvious to select one specie from a genus containing a million elements without some guidance. However, if the genus only contains say 10 elements, then there is no need for any guidance to select any of the elements of the genus. Further, Applicant's claimed invention is also a genus. Generic formulas are given that account for thousands of compounds and variations. Lin is not even that broad. Further, Lin's preferred polymers are the

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same as Applicant's preferred polymers. So it is not seen that there is a lack anticipation where the reference specifically directs the skilled artisan to used the claimed materials.

6. Claims 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin as set forth above, in view of the recognized state of the art of carpet fibers.

Applicant argues against this rejection stating that Lin does not disclose or suggest every feature of the claimed invention. This is why the rejection is under section 103 of the Statute and not section 102. It is also stated that it would not be expected from Lin that the claimed shrinkage behavior would be observed or that the stain resistance would be observed at sheath contents below about 10%. However, Applicant provides no evidence to support these accusations. Further, the sheath content argument is not commensurate in scope with the claimed invention.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Terrel Morris whose telephone number is (703) 308-2414. The Examiner can normally be reached Monday through Thursday from 7:00 am to 4:00 pm and on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Marion McCamish, can be reached at (703) 308-3961. The official fax phone number for this Group is (703) 305-5433 while the number for unofficial fax communication is (703) 308-4315.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.


Terrel Morris
Primary Examiner
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September 17, 1997